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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,947	10/05/2005	Tooru Yamakita	05670/LH	3610
1933 7590 06/16/2010 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER				
MISLEH, JUSTIN P				
ART UNIT		PAPER NUMBER		
2622				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,947

Applicant(s)

YAMAKITA, TOORU

Examiner

Justin P. Misleh

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 10 and 13 - 16 is/are pending in the application.
4a) Of the above claim(s) 14 and 16 is/are withdrawn from consideration.
5) ☒ Claim(s) 10 is/are allowed.
6) ☒ Claim(s) 1, 3, 13 and 15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 20, 2010 has been entered.

Election/Restrictions

2. Newly added **Claims 14 and 16** are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Applicant's application shows at least two patentably distinct species under same genus. The first species (embodiment) is directed to the camera, db management server (2), and db (3) portion of the system (see figure 1). The second species (embodiment) is directed to the tag reader/writer (6) and processing unit (7) portion of the system (see figure 1). Figures 2, 3, 6 – 8 are directed to the first species; while figures 4 and 9 are directed towards the second species. The original claim set (Claims 1-9) had claims directed towards an image pickup apparatus (Claims 1 – 4), an electronic tag reading apparatus (Claims 5 – 7), and a computer program product (Claims 8 and 9). Claims 1 – 4, 8, and 9 were clearly directed towards the first species and Claims 5 – 7 appeared to be generic to both species. Since the majority of claims were directed towards the first species, Applicant inherently elected the first species. The Examiner based the rejections in the Non-Final

Rejection (mailed May 29, 2008) on Applicant's election. However, in the latest amendment (filed January 20, 2010), Claims 1, 3, and 10 continue to be directed towards the first species. New Claims 13 and 15 also appear to be directed towards the first species. However, new **Claims 14 and 16** are direct towards the second species.

3. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, **Claims 14 and 16** are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

4. Applicant's arguments filed January 20, 2010 have been fully considered but they are not persuasive.

5. Applicant main argument is directed towards Boles and alleges that Boles does not disclose where the electronic tag is attached to the article.

6. The Examiner respectfully disagrees with this position. Paragraph 0042 of Boles explicitly describes a feature in which an image of the valuable is already stored in an RFID tag that is actually attached to the valuable itself such that at a later time, an electronic tag reader can read the image of the valuable stored in the attached RFID and compare that image to newly acquired images of the valuable. In paragraph 0035, Boles discloses the process of storing images of a valuable in an RFID tag that corresponds to that valuable.

7. Applicant's secondary argument is directed towards Lane et al. and appears to allege that Lane et al. do not disclose granting read/write permissions for an RFID tag based on information from that tag and a database.
8. The Examiner also respectfully disagrees with this position. The Examiner respectfully notes that Applicant's above-argument with respect Lane et al. is merely a conclusion drawn by Applicant. Applicant has not provided any reasons why Applicant believes Lane et al. do not disclose what the Examiner asserts Lane et al. disclose.
9. For all of the foregoing reasons, the Examiner will maintain the rejection.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claim 13** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Independent/parent Claim 1 requires an image capture apparatus. The image capture apparatus of the present invention is shown in figures 1 – 3 as element 1. Figures 1 and 2 both show exterior views of the image pickup apparatus and figure 3 shows the interior details of the image pickup apparatus. Specifically, figure 3 shows the image capturing apparatus having the image capture device, the display device, the electronic tag reader, the determining device and

the electronic tag writer as required by Claim 1 and the communication interface as required by Claim 3. However, figure 3 does not show the database required by Claim 13. Rather, as shown in figure 1, the image capture apparatus does not comprise a database. In fact, the database is completely external to the image capture apparatus. Moreover, there is no indication in the specification that the image capture apparatus may comprise the database required by Claim 13. Thus, Claim 13 contains impermissible new matter.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 1, 3 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boles (US 2005/0103840 A1) in view of Lane et al. (US 7,333,001 B2)

Claim 15 is a computer program product claim that tracks apparatus Claim 1. For the sake of brevity, Claims 1 and 15 will be rejected using the language of Claim 1. The Examiner respectfully notes the “computer readable medium” recited in Claim 15 appears to refer to the internal memory of the CPU described in the specification (see, e.g., page 17, lines 9 – 11) and is statutory.

14. For **Claims 1 and 15**, Boles discloses, as shown in figures 1 and 2 and as stated in paragraphs 34 – 37, 40, and 42, an image capture apparatus (6, 1, 3, 2 and 11) comprising:

an image capture device (SEM 11) which captures an image of an article (stone 12 or valuable V);

a display device (3) which displays the image of the article (stone 12 or valuable V) captured by the image capture device (see Boles, paragraph 34);

an electronic tag reader (6) which reads electronic tag information from an electronic tag (7), which is attached to the article (see Boles paragraph 42), when the image capture device captures the image of the article (see Boles paragraph 42); and

an electronic tag writer (6) which writes the image data of the article captured by the image capture device (11) into the electronic tag (See paragraphs 34 – 36. Boles states, “The resulting digitized images are output to an inductive writer 6 which is arranged to store the images in a memory 8 of a miniature RFID ... tag 7.”).

However, Boles does not disclose a determining device which determines whether or not writing of data into the electronic tag is permitted based on electronic tag information read by electronic tag reader.

On the other hand, Lane et al. also disclose an apparatus for reading/writing from/to an electronic tag attached to an article. More specifically, Lane et al. show, in figure 1, a system comprising a computer (40), a database (12), an RFID tag (4), and an RFID reader (10). Lane et al. show, in figure 2, details of the RFID tag (4). Additionally, in figures 3, 7, and 8, Lane et al. show granting reading/writing permission to the RFID reader (10) to read/write from/to the RFID tag (4). In this regard, Lane et al. specifically disclose, “The controller 4A may then access the security circuit 4F to authenticate the identity of the reader 10 and to determine if the reader 10 is authorized to request information from, or write information into, or otherwise direct

the operation of the RFID tag 2” (see Lane et al., column 15, lines 40-44). The Lane et al. reader (10) in combination with the controller (4A) satisfy the claimed “determining device” Advantages of the invention in Lane et al. include improving the security and accuracy of the data stored in an electronic tag (see column 5, lines 5 – 19).

Based on these factual findings, the Examiner respectfully submits that, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to have included a decision unit which determines whether a writing of *data* is permitted, and wherein the writing device writes the *data* into the electronic tag when the decision unit determines that a writing of the *data* is permitted, as taught by Lane et al., in the image pickup apparatus disclosed by Boles.

15. As for **Claim 3**, Lane et al. further teach, as stated in column 16 (lines 36 – 52), a communication interface (20) which transmits the electronic tag information to a management server, wherein the determining device (10) determines whether or not writing of the image data of the article captured by the image capture device into the electronic tag is permitted by transmitting the electronic tag information read by the electronic tag reader to the management server via the communication interface and by receiving a response indicating whether or not writing is permitted from the management server (also see column 21, line 50 – column 22, line 5).

Allowable Subject Matter

16. **Claim 10** remains allowed.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Justin P Misleh whose telephone number is 571.272.7313. The Examiner can normally be reached on Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, David Ometz can be reached on 571.272.7593. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Justin P. Misleh/
Primary Examiner
Group Art Unit 2622
June 16, 2010**